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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/637,388	08/11/2000	JAMES B. RILEY	013284-05551	8885
22914	7590	02/17/2006	EXAMINER	
KEVIN P. CROSBY BRINKLEY MCNERNEY MORGAN SOLOMAN & TATUM LLP 200 E. LAS OLAS BLVD, SUITE 1900 FORT LAUDERDALE, FL 33301			VAUGHN, GREGORY J	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 02/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/637,388	RILEY ET AL.	
	Examiner	Art Unit	
	Gregory J. Vaughn	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 70-81 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 70-81 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Action Background

1. This action is responsive to the applicant's request for reconsideration, filed on 12/1/2005.
2. The status of the claims remains unchanged with this response.
3. Claims 70-81 are pending in the case, claims 70, 74 and 78 are independent claims.
4. The examiner's rejection of claims 73, 77 and 81, made under 35 USC 102, as being anticipated by Gupta et al. US Publication US 2003/0196164 as recited in the previous office action (dated 9/1/2005) are withdrawn in view of the applicant's remarks. However, new grounds of rejection are described below.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention."

6. Claims 73, 77 and 81 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

7. **Regarding claim 73**, the amendment filed 6/15/2005 adds the following limitations: *"prohibiting access to the at least one document after completion of the interactive learning course"*. The examiner has reviewed the originally filed specification, and has failed to find support for the added limitation. Applicant is required to cancel the new matter in response to this office action.

8. **Regarding claims 77 and 81**, the claims contain the same new matter as described above in relation to claim 73, and are rejected using the same rationale.

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9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 73, 77 and 81 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. The term “*prohibiting access*” in claims 73, 77 and 81 is a relative term, which render the claims indefinite. The term “*prohibiting access*” is not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention. Furthermore, the originally filed disclosure fails to describe or suggest “*prohibiting access*” (see the 35 USC 112 first paragraph rejection stated above).

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

"A person shall be entitled to a patent unless –

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language."

13. Claims 70-72, 74-⁷⁶~~74~~ and 78-80 are rejected under 35 U.S.C. 102(e) as being anticipated by Gupta et al. US Patent publication 2003/0196164, filed 9/15/1999, published 10/16/2003 (hereinafter Gupta). wss

14. **Regarding independent claim 70**, Gupta discloses electronic note taking during an interactive learning course. Gupta discloses an interactive learning system with students and instructors. Gupta recites: *"These annotations typically correspond to a particular temporal location in the multimedia presentation and can provide a replacement for much of the "in-person" interaction and "classroom discussion" that is lost when the presentation is not made "in-person" or "live". As part of an annotation, a student can comment on a particular point, to which another student (or lecturer, assistant, etc.) can respond in a subsequent annotation. This process can*

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continue, allowing a "classroom discussion" to occur via these annotations" (page 1, paragraph 6).

Gupta discloses a document annotation system. Gupta recites: *"According to one aspect of the invention, multiple annotations are maintained together as an annotations collection corresponding to particular multimedia content"* (page 1, paragraph 12), where Gupta defines the multimedia content as: *"The data can be as simple as ASCII text or as complex as HTML code which can include text having different fonts and type styles, graphics including wallpaper, motion video images, audio, and links to other multimedia documents"* (page 5, paragraph 66).

Gupta disclose an annotation field associated with a document. Gupta recites: *"FIG. 5 shows an exemplary structure for an annotation entry 180 that is maintained by annotation server 10 in annotation meta data store 18 of FIG. 3. In the illustrated example, the annotation entry 180 includes an author field 182, a time range field 184, a time units field 186, a creation time field 188, a title field 190, a content field 192"* (page 5, paragraph 59). Gupta discloses receiving the entry of notes in the annotation field in figure 8 at reference sign 276.

Gupta discloses storing the annotations in memory and associating them with a document. Gupta recites: *"annotations typically correspond to a particular multimedia presentation. Since each of the different versions of the multimedia content is a different multimedia presentation, typical annotations correspond to only one of these presentations"* (page 1, paragraph 8).

Gupta discloses providing access to the document and notes during the interactive learning course. Gupta recites: *"As part of an annotation, a student can comment on a particular point, to which another student (or lecturer, assistant, etc.) can respond in a subsequent annotation. This process can continue, allowing a "classroom discussion" to occur via these annotations"* (page 1, paragraph 6).

Gupta discloses providing access to the entered notes after the completion of the interactive learning course. Gupta recites: *"Additionally, some systems allow a user to select a particular one of these annotations and begin playback of the presentation starting at approximately the point in the presentation to which the annotation corresponds"* (page 1, paragraph 6).

15. **Regarding dependent claim 71**, Gupta discloses the note containing content contained in the document. Gupta recites: *"multimedia content is duplicated in the annotation"* (page 1, paragraph 9).
16. **Regarding dependent claim 72**, Gupta discloses a plurality of users, where the users can share notes for a period of time. Gupta recites: *"As part of an annotation, a student can comment on a particular point, to which another student (or lecturer, assistant, etc.) can respond in a subsequent annotation. This process can continue, allowing a "classroom discussion" to occur via these annotations"* (page 1, paragraph 6).

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17. **Regarding claims 74-76**, the claims are directed toward a computer readable storage medium for the method of claims 70-72, respectively, and are rejected with the same rationale.
18. **Regarding claims 78-80**, the claims are directed toward a system for the method of claims 70-72, respectively, and are rejected with the same rationale.

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

“(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.”

20. Claims 73, 77 and 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta in view of Bohlen et al., “The effect of Learning Style and Method of Instruction on the Achievement, Efficiency and Satisfaction of End-Users Learning Computer Software” Published on the Internet by ACM, 1993 (hereinafter “Bohlen”).
21. **Regarding dependent claim 73**, Gupta discloses a document based interactive computer based learning, as described above. Gupta discloses controlling access to the interactive learning annotations. Gupta recites:

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"According to one embodiment of the invention, annotation server 10 of FIG. 3 supports read and write access controls ... to the annotation set" (page 7, paragraph 90). Gupta fails to explicitly describe controls for the learning material. Bohlen discloses a study of the effectiveness of computer-based training (abstract, page 273), where a lecture course was compared to a computer based training method, wherein results were determined by test scores (page 277, second, third and last paragraphs). Bohlen discloses subject matter testing, and it is well known in the educational arts that testing is traditionally undertaken after completion of the learning course in a "closed book" environment, wherein access to the learning material is prohibited.

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to combine prohibiting access to learning course material, as taught by Bolen, with the annotations control of learning course documents of Gupta, in order to effectively test learning course students as to the degree of effectiveness of the learning course.

Response to Arguments

22. Applicant's arguments filed 12/1/2005 with respect to claims 70, 74 and 78 have been fully considered but they are not persuasive.
23. **Regarding claims 70, 74 and 78**, the applicant argues "*Gupta does not provide access to the entered notes after completion of the interactive learning course*" (page 2, third paragraph, of the response filed 12/1/2005). Applicant is directed to the rejection of claim 70 as restated above. Gupta discloses providing access to the entered notes after the completion of the interactive learning course. Gupta recites: "*Additionally, some systems allow a user to select a particular one of these annotations and begin playback of the presentation starting at approximately the point in the presentation to which the annotation corresponds*" (page 1, paragraph 6).
24. **Also regarding independent claims 70, 74 and 78**, the applicant argues: "*Gupta only permits review of annotations or notes during playback of the course. By contrast, applicants' claims allow a user to view the annotation without playback of the presentation*" (page 2, third paragraph, of the response filed 12/1/2005). In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "*without playback of the presentation*") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are

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not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

25. Applicant's arguments with respect to claims 73, 77 and 81 have been considered but are moot in view of the new ground(s) of rejection, as described above.

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Conclusion

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory J. Vaughn
February 9, 2006

William L. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER
2/15/2006